

REMARKS

Claims 1-5 and 7-12 are pending in this application. Claim 1 is the sole independent claim. By this Amendment, claim 1 is amended only to correct antecedence issues and therefore no new matter is added that would require additional consideration and/or search. Claims 13-22 are cancelled without prejudice or disclaimer.

Interview

A telephone interview was conducted with Examiner Nguyen to determine if the Examiner would be willing to rejoin withdrawn claims 15-20 on the grounds set forth in the several traversals of the Restriction Requirement presented during prosecution of the present application (see for example, reasons provided herein below). The Examiner indicated that he believed his Restriction to be appropriate and was unwilling to withdraw the Restriction and rejoin any of the withdrawn claims.

Attempts to contact Examiner Nguyen's Supervisor, SPE Ross, were made on August 17, 19 and 25, 2009, to discuss the issue. During the interview conducted on August 26, 2009, Applicant's representative pointed out to SPE Ross that Examiner Nguyen's Restriction was not in keeping with the rules of unity of invention and was incorrect for the several reasons which we discussed in the Response to Restriction Requirement. Although SPE Ross did not necessarily disagree with our position, he indicated that he would support the Examiner and suggested that if we wish to proceed further with the traversal that a Petition to the Director of the Art Unit requesting rejoinder of the withdrawn claims should be submitted.

Restriction Requirement

Applicant again traverses the restriction of the claims. The Examiner appears to interpret PCT Rule 13.2 as indicating that if there is a single feature different among the claims that there is no unity of invention. However, such an interpretation is incorrect. Rather, PCT Rule 13.2 recites that the requirements of unity of invention shall be fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" means those features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. In other words, when a single special technical feature is shared, there is unity of invention.

Applicant asserts that at least Groups I, III and IV share a least one special technical feature. For example, claim 1 of Group I recites “wherein seam contact surfaces of the can jacket and the closure member that are pressed against each other prior to the welding of the closing seam are embodied as ring-shaped circumferential edge regions which are at least one of expanded and necked down in a direction along the can axis for the welding of the closing seam, the method comprising: pushing the can jacket and the at least one closure member together, with the edge regions getting to a stop position, wherein from the end faces of the two edge regions one is positioned on the inside and one on the outside of the can body; forming the closing seam when two air-free adjoining seam contact surfaces are at a stop position against each other.” Claim 15 of Group III recites corresponding features. Therefore, Groups I and III share at least one special technical feature. Moreover, as claim 21 of Group IV specifically incorporates all of the features of claim 1, the claim must share at least one special technical feature with Groups I and III.

As at least Groups I, III and IV share special technical features, the restriction is inappropriate.

Allowable Subject Matter

Claims 1-5 and 7-12 are indicated as being allowable if amended to overcome the rejection under 35 USC §112, second paragraph. As the claims are amended as indicated below, claims 1-5 and 7-12 are in condition for allowance.

Claim Rejections Under 35 USC §112

Claims 1-5 and 7-12 are rejected under 35 USC §112, second paragraph, for antecedent basis issues. As claim 1 is amended to address the antecedent basis issues pointed out in the Office Action, withdrawal of the rejection is respectfully requested.

CONCLUSION

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick, Reg. No. 41,018, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.C.

By: 

John W. Fitzpatrick, Reg. No. 41,018

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/JWF:hcw